

In re Application of: Tami HAREL et al  
Serial No.: 10/804,560  
Filed: March 18, 2004  
Office Action Mailing Date: August 8, 2007

Examiner: Michael William Kahelin  
Group Art Unit: 3762  
Attorney Docket: 34487

### **REMARKS**

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 39-43 and 45-100 are in this Application.

Claims 39-43, 45-51, 56-64, and 88-100 are withdrawn from consideration.

Claims 78-81 and 85 are rejected under 35 U.S.C. §112.

Claims 52, 53, 78, 79, and 81-86 are rejected under 35 U.S.C. §102.

Claims 50, 80, and 87 are rejected under 35 U.S.C. §103.

Claims 39-51, 56-78, and 88-100 are cancelled herewith.

Claims 52, 79-81, and 85 are amended herewith.

Claims 101-102 are added herewith.

### **Amendments To The Claims**

#### **New claims**

Claims 101 and 102 are added herewith to further claim some embodiments of the present invention.

Claim 101 is supported at least by claim 24 of the application as filed.

Claim 102 is supported at least by claim 26 of the application as filed.

#### **Rejections under 35 U.S.C. 112**

Claims 78-81 and 85 stand rejected under 35 U.S.C. 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 78-81 are rejected because they refer to a compensation, and the term compensation does not have antecedent basis. These claims are currently amended not to refer to compensation. Thus, Applicants respectfully submit that the rejection is moot.

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Claim 85 is rejected without any explanation. The claim is currently amended to improve language consistency with parent claim 52 and to improve definition of the invention claimed in claim 85.

Rejections under 35 U.S.C. 102 and 103

**Independent claim 52**

Independent Claims 52 stands rejected under 35 U.S.C. 102 as being anticipated by Houben (U.S. 5,919,216).

Applicants respectfully traverse; and submit that claim 52 is not *prima facie* obvious.

Claim 52 is amended to relate to an apparatus having a "circuitry adapted to electrify said at least one electrode and configured to electrify said electrode in a manner which generates an electric field that significantly reduces elevated blood glucose levels, said circuitry configured to apply said field also when glucose levels are not elevated".

The claim is amended to make it even clearer than it was before, that also when glucose levels are not elevated, the circuitry is configured to apply a field that reduces elevated blood glucose levels.

Independent Claim 52 contains the limitation that the apparatus includes circuitry "configured to apply said field also when glucose levels are not elevated". Applicants respectfully submit that Houben does not disclose such a circuitry.

The Examiner states that "Houben discloses an electrode for applying electric field to the pancreas and circuitry for electrifying the electrode to significantly reduce blood glucose and also apply the field when glucose levels are not elevated". Applicants respectfully traverse.

Applicants respectfully submit that Houben does not teach a circuitry "configured to apply said field in said manner also when glucose levels are not

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elevated". On the contrary, Houben teaches that "care must be taken not to induce hypoglycemia by excessive insulin production. This can be avoided by programming a break in insulin production after a predetermined interval in order to check for glucose level, after which insulin production can [be] adjusted accordingly, i.e., inhibited." (Houben, column 3, lines 4-9)

The programming described by Houben in the above-cited passage is specifically designed to avoid applying a field "which significantly reduces elevated blood glucose levels", as claimed when these levels are not elevated.

Thus, Houben does not anticipate claim 52, but in fact, teaches against this claim.

Applicants note that Houben indeed describes applying a field when glucose levels are not elevated, nevertheless, this field is not one "which significantly reduces elevated blood glucose levels", as claimed.

**In summary, Applicants respectfully submit that claim 52 is not prima facie anticipated by Houben.**

In addition, Applicants should note that a claim identical to claim 52 was pending as claim 45 in application 10/526,708, where it was rejected by Examiner Flory under 35 U.S.C. 102 as being anticipated by Houben (discussed above) and also by Klettner (US 5,013,617) and by Findl (US 4,428,366).

Applicants respectfully submit that neither Findl nor Klettner describes an "implantable electrode adapted to apply electric field to the pancreas", electrified by a circuitry "configured to apply said field also when glucose levels are not elevated".

Findl's apparatus is *capable of* applying a field also when glucose levels are not elevated, but is not *configured* to do so.

Klettner is directed to treatment of hyperglycemic conditions.

Furthermore, neither Findl nor Klettner discloses an apparatus with an implantable electrode, but rather each is concerned with applying electric field from outside the body.

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**Dependent claims 53-55, 78-87, and 101-102**

All the dependent claims depend, directly or indirectly, on independent claim 52, discussed above, and are accordingly patentable at least for the virtue of being dependent on a patentable base claim.

Nevertheless, Applicants wish to draw the Examiner's attention to the further patentability of some dependent claims over Houben:

Claim 53 contains the limitation that "said circuitry is configured to *over stimulate* in cases of doubt" [emphasis added]. Houben is against over stimulation.

Claim 54 contains the limitation "where a relatively long stimulation series is applied without feedback". Houben is afraid of harming the patient if stimulation is applied when not required, and therefore, teaches against applying a relatively long stimulation series without feedback.

In addition, Applicants respectfully submit that the rejections made under 35 U.S.C. 103 were improper in relying on common knowledge without following the procedures detailed in MPEP 2144.03.

The Examiner stated that "it is well known in the art to provide semi-open loop systems wherein a relatively long stimulation is applied without feedback to conserve processor resources and battery life when controlling variables that do not require extremely precise control". If the Examiner made an official notice or cited a specific art, it would have been easier to respond to the rejection. However, even if it is well known in the art, no prima facie case of obviousness has been set forth, because it has not been established that electrically stimulating the pancreas with an implantable electrode when glucose levels are not elevated does not require extremely precise control. In fact, Houben suggests the opposite, as discussed above.

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In view of the above amendments and remarks it is respectfully submitted that claims 52-55, 78-87, and 101-102 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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Date: January 7, 2008

**Encl.:**

Petition for Extension (2 Months)  
Additional Claims Transmittal